REMARKS

Applicants have studied the Office Action dated January 30, 2004 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-21 are pending. Claims 13 and 15 were amended to correct informalities. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- Rejected claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over Chang et al. (U.S. 6,134,584) in view of Klug et al. (US 2004/0010546 A1).

Commonly Owned Reference - Chang

As noted above, the Examiner erroneously claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over Chang et al. (U.S. 6,134,584) in view of Klug et al. (US 2004/0010546 A1). The Applicants submit that under 35 U.S.C. § 103(a), the subject matter of the reference Chang cited by Examiner and of the presently claimed invention was commonly owned at the time the claimed invention was made, and that this effectively disqualifies the cited reference as prior art under 35 U.S.C. § 103 (a) for purposes of an anticipation rejection. See also MPEP § 706.02 (l) (3), specifically directs Examiners to check the assignment records to determine common ownership. Note that the cited reference Chang and the subject matter of the presently claimed invention have been, and are currently, assigned to the same common owner, i.e., the International Business Machines Corporation. Note also that the date of the Chang reference is October 17, 2000, while the filing date of the present patent application is July 7, 2000. The Chang reference, accordingly, is being cited under 35 U.S.C. § 103(a) for an obviousness rejection. Therefore, on this rejection basis discussed above, Applicants submit that the subject matter of the Chang reference should be disqualified from relevant prior art under 35 U.S.C. § 103 (c) for purposes of an obviousness rejection.

Klug Reference

As noted above, the Examiner rejected claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over Chang et al. (U.S. 6,134,584) in view of Klug et al. (US 2004/0010546 A1). On page 3 of the Office Action the Examiner correctly states *"Chang does not explicitly disclose: [...] Obtain percentage of CPU utilization of the client"* and goes on to combine Chang with Klug.[1] Careful reading of Klug at paragraph 0053 reproduced below for convenience states:

> If time information is to be utilized (90) the program determines (91) the approximate waiting time associated with a particular website access request. The approximate waiting time depends on a number of factors including the speed of the server at the selected website, the level of congestion on the Internet and any rerouting required by such congestion, the bandwidth of each leg of the route between the selected website and the user node, the processing speed of the user node, the operation of the browser, and the size and number of files that are downloaded before display can begin. Ideally, as many of these factors as possible should be taken into account in determining the approximate waiting time. For example, the headers of protocol communications between the browser and the selected website convey information regarding the quantity of information that is to be downloaded. Such data is commonly used to provide displays during loading such as "15% of 7K" or the like. This information can used to gain some information regarding the approximate waiting time, although it will be appreciated that actual waiting time may be longer than expected as multiple files may be linked by tags, i.e., a message embedded in one file may direct the browser to access another file at the selected website. The program can use such file size information together with information regarding the speed of the user node processor, the operation of the browser and empirical data gained through experience to approximate the waiting time and identify (92) messages to be displayed

[1] Applicants make no statement whether such combination is even proper.

> or played during the waiting time. Additionally, information regarding the expected waiting time and regarding the fastest communication network at the current time may be obtained by "pinging" one or more communications networks, e.g., issuing network access requests to the network(s) and measuring the response time for receiving a responsive signal.

(Emphasis Added).

The Applicants respectfully submit that "the processing speed of the user node" is not the same as "*obtain percentage of CPU utilization of the client*" as recited in independent claims 1, 11 and 21 and *"checking a percentage of CPU utilization of a client computer"* in independent claims 9 and 19. The use of "the processing speed of the user node" as taught by Klug is in reference to how "fast" a user node is running e.g. what "speed" which is typically measured in Megahertz (or higher units e.g. Terahertz of time). In contrast, as recited in the independent claims of the present invention, the percentage utilization of a CPU is a measure of how "busy" a processor is at any given time. The determination of speed in the present invention is not necessary rather just how much of the processor is being consumed. This is important because often times in the downloading step it is the utilization (especially the processor I/O) which determines how fast something is downloaded. The CPU speed difference is negligible. Furthermore, the CPU utilization changes over time, the processor speed is fixed.[2] To use an analogy of a measuring cup used in cooking, the "processor speed" or "CPU speed" is a measure directed to a size of a measuring cup whereas, the "percentage CPU utilization" is how full is the measuring cup. The two are different. Accordingly, independent claims 1, 9, 11, 19, and 21 distinguish over Chang taken alone and/or in view of Klug for this reason as well.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the

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[2] To be complete in more advanced processor designs, the actual processor speed may be throttled for portable devices, such as for laptop computers, in an effort to conserve battery life but this is different than CPU percentage utilization which changes based on the demands of each process and/or application running.

invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot be properly made. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Klug taken alone or in view of Chang is the measure of *"processor speed"*, in contrast to the intent and purpose of the present invention which is the measure of *"percentage of CPU utilization"*. The present invention is more accurate in measuring the amount of available CPU at any given time, whereas CPU speed is constant over time. This combination, as suggested by the Examiner, destroys the intent and purpose of Klug taken alone or in view of Chang's teaching of measuring *"processor speed"*. Accordingly, independent claims 1, 9, 11, 19, and 21 of the present invention distinguish over Chang taken alone and/or in view of Klug for this reason as well.

For the foregoing reasons, independent claims 1, 9, 11, 19, and 21 distinguish over Chang taken alone and/or in view of Klug. Claims 2-8, 10, 12-18, and 20 depend from independent claims 1, 9, 11, 19, and 21 respectively. Since dependent claims contain all the limitations of the independent claims, claims 2-8, 10, 12-18, and 20 distinguish over Chang taken alone and/or in view of Klug, as well, and the Examiner's rejection should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith in the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the

territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: April 30, 2004 By: _____

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